

REMARKS

Reconsideration of the subject application in view of the present amendment is respectfully requested.

By the present amendment, claim 1 has been amended to yet more clearly define the present invention. Claim 6 has been canceled and claim 7 has been added.

Based on the foregoing amendments and the following remarks, the application is deemed to be in condition for allowance, and action to that end is respectfully requested.

The Examiner rejected claims 1, 2, and 5 under 35 U.S.C. § 102(b) as being anticipated by Rognmo, U.S. Patent No. 4,157,068 (Rognmo). Claim 3 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Rognmo in view of Jacobson et al., U.S. Patent No. 4,127,243 (Jacobson). Claim 4 was also rejected under 35 U.S.C. § 103(a) as being unpatentable over Rognmo in view of Saxe et al., U.S. Patent No. 4,072,107 (Saxe). It is respectfully submitted that claims 1-5 and 7 are patentable over the cited references.

Specifically, the present invention relates to internal combustion-operated setting tool and, in particular, to propellant container for such tools. Rognmo

relates to a missile for discharge towards a target. It is respectfully submitted that the preamble of claim 1 alone distinguishes the present invention over Rognmo.

Applicants rely on both the preamble and the claim body to define the present invention. Specifically, claim 1 recites that the electrical power supply is arranged on the propellant container to be contacted by the contact elements that are, as mentioned in the preamble, form part of a setting tool for supplying power to electrical consumers of the setting tool.

The case law holds that

Preamble limits the claim when it indicates reliance on both the preamble and the claim body to define the claimed invention. *Bell Communication Research, Inc. v. Vitalink Communication Corp.*, 34 U.S.P.Q. 2d 1816, 1820 (Fed. Cir. 1995).

Moreover, the case law holds that

clear reliance on the preamble during prosecution to distinguish the claimed invention from the prior art transforms the preamble into a claim limitation because such reliance indicates use of the preamble to define in part, the claimed invention. *Catalina Mktg. Int'l, Inc. v. Coolsavings.com, Inc.*, 62 U.S.P.Q. 2d 1781, 1784 (Fed. Cir. 2002) quoting *Bristol-Myers Squibb Co. v. Ben Venue Labs. Inc.*, 58 U.S. P.Q. 2d 1508, 1513 (Fed. Cir. 2001).

The Court pointed out that this reliance should be clear and unmistakable.

This is clearly the case here. Throughout the specification and during the entire prosecution, the applicants emphasize that the invention is directed to setting tools to solve a specific problem particular to the setting tools, and not any setting tools but to setting tools having contact elements for supplying electrical power to electrical consumers of the setting tool, reciting in the body of the claim that the power supply is mounted on the propellant container to be contacted by the contact elements of the setting tool.

In *Bell Communication Research, Inc., v. Vitalink Communication Corp.*, the Court held that when the same phrase is included twice, in the preamble and the body of the claim, the respective phrase limits the claim.

As it has already been discussed previously, it is respectfully submitted that neither Rognmo nor Jacobson which relates to a device for a missile, or Saxe which relates to missile control means are pertinent to the present invention.

The case law holds that in order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned. *In re Oetiker*, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). See also *In re Deminski*, 230 USPQ 313 (Fed. Cir. 1986); *In re Clay*, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992).

In the present case, none of Rognmo, Jacobson or Saxe is neither in the field of applicant's endeavor nor is reasonably pertinent to the particular problem the applicant was concerned with.

The object of the present invention is to facilitate handling by the operator of the setting tool and the propellant container, which is achieved by mounting the power source on the propellant container.

The objects of Rognmo are to provide a finished assembled missile which can be stored for longer periods of time without the electrical or electronic components being damaged, and to provide a missile which during and after the launching has an extra safety against unintentional detonation of the explosive charges caused by the influence of undesired jamming signals. These objects are achieved in a missile which is characterized in that the power source of each explosive element is a chargeable condenser battery, which during the flight of the missile is connected to and charge by the power source of the missile.

Clearly, neither the problems Rognmo solves nor the solution are similar to those of the present invention. The objects and solutions of Jacobson and Saxe are even more remote than those of Rognmo.

In view of the above, it is respectfully submitted that Rognmo, whether taken alone or in combination with Jacobson and/or Saxe does not anticipate or make obvious the present invention, as defined by claim 1, obvious, and claim 1 is

patentable over Rognmo whether taken alone and/or in combination with Jacobson and/or Saxe.

Claims 2-5 and 7 depend on claim 1 and are likewise allowable.

CONCLUSION

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance, and allowance of the application is respectfully requested.


Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place the case in condition for final allowance, it is respectfully requested that such amendment or correction be carried out by Examiner's Amendment and the case passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, the Examiner is invited to telephone the undersigned.

Respectfully submitted,


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